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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,148	03/10/2006	Stephan Ducret	2737	7152
26936 7590 11/15/2007 SHOEMAKER AND MATTARE, LTD 10 POST OFFICE ROAD - SUITE 110 SILVER SPRING, MD 20910			EXAMINER GUADALUPE, YARITZA	
			ART UNIT 2859	PAPER NUMBER
			MAIL DATE 11/15/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/552,148

Applicant(s)

DUCRET, STEPHAN

Examiner

Yaritza Guadalupe-McCall

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____                                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/11/2006</u> .   | 6) <input type="checkbox"/> Other: ____                           |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 4 and 10 are rejected under 35 U.S.C. 102 ( b ) as being anticipated by Conti (US 1,611,140 ).

With respect to claim 1, Conti discloses a device for labeling circular data carriers characterized by a stencil ( 1 ), on which labels ( 7 – 14 ) are arranged as apertures, means (3, 16) for the rotationally movable mounting of the stencil and/or the data carrier about an axis of rotation being present in such a way that the stencil lies plane-parallel over the data carrier and that, for sequentially applying the labels, the stencil and the data carrier are rotatable in relation to each other about the center of the data carrier.

Regarding claim 2, Conti further discloses a device for labeling data carriers with a central opening ( receiving bolt and nut ), characterized in that the stencil ( 1 ) has a mounting opening of a diameter made to match the diameter of the central opening on the data carrier in such a way that the stencil can be placed rotatably onto a mount penetrating through the central opening.

In regards to claim 3, Conti further shows a device characterized in that wherein the stencil ( 1 ) is likewise formed as a circular disk, its outside diameter being at least approximately the same size or greater than that of the data carrier and the mounting opening being arranged in the center ( See Figure 2 ).

With regards to claim 4, Conti teaches a device characterized in that wherein the stencil (1) has on its side facing the data carrier spacing elements preferably in the form of an inner spacing ring, surrounding the mounting opening ( See Figure 1 ), and an outer spacing ring, surrounding the labels.

Regarding claim 10, Conti shows a device wherein the labels ( 7 – 14 ) on the stencil are arranged on preferably a number of circular rings, which run concentrically in relation to the axis of rotation.

3. Claims 1 and 9 are rejected under 35 U.S.C. 102 ( b ) as being anticipated by Conti (US 1,672,751 ).

With respect to claim 1, Conti discloses a device for labeling circular data carriers characterized by a stencil ( 25 ), on which labels ( 29 ) are arranged as apertures, means ( 26 ) for the rotationally movable mounting of the stencil and/or the data carrier ( B ) about an axis of rotation being present in such a way that the stencil lies plane-parallel over the data carrier and that, for sequentially applying the labels, the stencil and the data carrier are rotatable in relation to each other about the center of the data carrier.

Regarding claim 9, Conti also shows a device characterized in that the stencil ( 25 ) is produced from a transparent or partly transparent material ( See page 1, lines 99 – 100 ), preferably from a plastics material.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conti ( US 1,611,140 ) in view of Koch ( US 6,543,508 ).

Conti discloses a device as stated in paragraph 2 above.

Conti does not disclose the carrier element as stated in claim 5.

With respect to claim 5 : Koch discloses a device for labeling discs comprising a carrier element ( 13b ) with a mount ( 19 ) penetrating through the central opening of the data carrier (21), it being possible for the data carrier to be connected in a rotationally secure manner to the carrier element at least when the stencil ( 20 ) is in place. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device disclosed by Conti by providing a carrier element as taught by Koch in order to provide a structure to help align the data carrier and the stencil when labeling.

6. Claims 6 – 8 and rejected under 35 U.S.C. 103(a) as being unpatentable over Conti ( US 1,611,140 ) in view of Koch ( US 6,450,229 ).

Conti discloses a device as stated in paragraph 2 above.

Conti does not disclose the storage case as stated in claims 6 - 8. Conti does not disclose the wall opening as stated in claim 11.

Regarding claims 6 – 7 and 11 : Koch discloses a device for labeling discs comprising a storage case (10, Figure 6 ) with two wall portions ( 13, 34 ) arranged at a distance from each other and with mounting means ( 14 ) for the rotatable mounting of the data carrier ( 24 ) between the wall portions, and in that one of the wall portions contains the stencil ( 26 ); wherein the storage case is formed as a cassette with a mounting base for receiving the data carrier ( 24 ) and with a hinged cover ( 34 ) and in that the stencil ( 26 ) is arranged in the cover; wherein at least one of the wall portions has an opening ( 18 ) for the manual turning of the data carrier (24). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device disclosed by Conti by providing a storage case as taught by Koch in order to provide a structure to help align the data carrier and the stencil when labeling.

In regards to claim 8: Conti and Koch disclose a labeling device as indicated above, comprising a storage case with a hinged cover. The use of the particular type of storage case claimed by applicant, i.e., formed as an insert case, absent any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as a storage case structure is provided, as already suggested by Conti and Koch, 2) the storage case claimed by Applicant and the storage case used

by Conti and Koch are well known alternate types of storage cases which will perform the same function, if one is replaced with the other, of providing an alignment structure for the data carrier and the stencil, and 3) the use of the particular type of storage case by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of storage cases that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to provide a structure to help in the alignment of the data carrier and the stencil as already suggested by Conti and Koch.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Buchert and Gilker ( US 1,179,070 )

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe-McCall whose telephone number is (571)272-2244. The examiner can normally be reached on 8:00 AM - 5:30 PM.



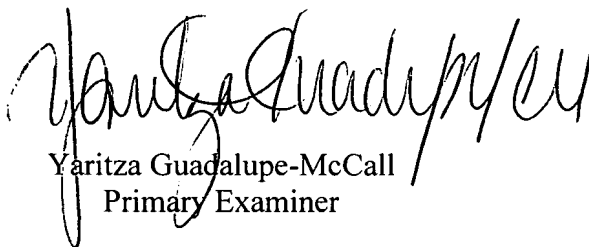
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YGM  
November 12, 2007  
Art Unit 2859

  
Yaritza Guadalupe-McCall  
Primary Examiner